

This Opinion is Not
Citable as Precedent
of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Physicians Practice, Inc.

Serial No. 76/186,809

Sherry H. Flax of Saul Ewing LLP for Physicians Practice
Inc.

Michael Engel, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Hanak, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Physicians Practice, Inc. has filed an application to register the mark PRACTICE MANAGEMENT PEARLS for services identified as "computer services, namely, providing on-line magazines relating to business, marketing, financial and general practice management for physicians and medical personnel via a global computer network," in International Class 42.¹ Applicant complied with the examining attorney's

¹ The application asserts a date of first use and first use of the mark in commerce of September 2000.

requirement for entry of a disclaimer of "practice management." However, applicant has argued against the examining attorney's refusal of registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the prior registration of certain other marks.

Specifically, the examining attorney has refused registration in view of the prior registration of the marks in the following two registrations owned by Medical Information Management Systems, Inc.: PEARL ONLINE (with a disclaimer of "online") for services identified as "providing physicians with professional information in the field of patient medical records via a web page on a global computer network," in International Class 42²; MEDICAL PEARLS (with a disclaimer of "medical") for the same services identified by the PEARL ONLINE mark, plus the additional services of "leasing access to an on-line computer program for use in the management of patient medical records," also in International Class 42³. Further, the examining attorney has refused registration in view of

² Registration No. 2,144,522, issued March 17, 1998, reciting a date of first use and first use in commerce as of January 1, 1997.

³ Registration No. 2,215,152, issued December 29, 1998, reciting dates of first use as of February 1997 and first use in commerce as of April 1997.

the prior registration of PEARLS FOR YOUR PRACTICE for goods identified as "column reprints and supplements to magazines relating to the dental field," in International Class 16, such registration owned by Pennwell Publishing Company⁴.

When the refusal was made final, applicant appealed and requested reconsideration. The appeal was suspended pending review of the request for reconsideration. After that request was denied, the appeal was resumed. Both applicant and the examining attorney have filed briefs. Applicant did not request oral argument.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the marks and the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental

⁴ Registration No. 2,267,086, issued August 3, 1999, reciting a date of first use and first use in commerce as of February 1999.

inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

We consider first the two registrations owned by Medical Information Management Systems. As noted, these cited registered marks are PEARL ONLINE and MEDICAL PEARLS and applicant's mark is PRACTICE MANAGEMENT PEARLS. While "online," "medical" and "practice management" all are disclaimed we nonetheless consider the marks in their entirety. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993). Even so, the disclaimed terms only result in marks that look and sound different but nonetheless have very similar commercial impressions.

In the absence of any information in the record tending to indicate that the presence of PEARL(S) in the marks would yield some other connotation (e.g., that of a calcium carbonate deposit formed around a grain of sand in an oyster, or mother-of-pearl) we consider each of the marks to have a laudatory connotation. See, e.g., *Webster's Third New International Dictionary* 1661 (1993) (...3: one that is very choice or precious: the finest or noblest of its kind: a supreme rarity <enunciated this ~ of wisdom - J.C. Snaith> <learned from him one tale which is a ~ of price - H.J. Laski>). Moreover, given the

descriptive, if not generic, nature of the disclaimed terms, it is the connotation of each mark that is likely to yield the most lasting impression for a prospective consumer of applicant's or registrant's respective services. In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

We find that PEARL and PEARLS dominate the respective marks, invest each mark with a very similar connotation, and will result in a likelihood of confusion if the marks are used on or in connection with services that prospective users will view as likely to emanate from the same source. See The Squirt Company v. Pola-Rona, Inc., 108 USPQ 333, 335 (CCPA 1956) ("In determining likelihood of confusion between marks on identical, or very similar, goods, it is proper to consider their appearance, sound and meaning. (citation omitted) However, a combination of all three of

these factors need not necessarily exist, and an opposition to registration may be sustained if the marks are so similar in either appearance, sound or meaning as to be likely to cause confusion."); In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988) ("In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar.'" (citations omitted)).

Turning, then, to the respective services, we begin by noting the well-settled principle that we must focus on the identifications in the application and registrations.

Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Each of the marks PEARL ONLINE and MEDICAL PEARLS is registered for the service of "providing physicians with professional information in the field of patient medical records via a web page on a global computer network."

Applicant's services also involve providing physicians (and others) with information via global computer network. That applicant's information is presented in an "on-line magazine" while registrant's is presented "via a web page" is not, in our view, a significant difference (nor does applicant contend that it is).

Applicant argues, however, that registrant's service is to "provide access to medical records" and that applicant's and registrant's consumers "would obtain business advice from Applicant and copies of patient medical records from registrant." We disagree. Applicant has misread registrant's identifications. While the registration for MEDICAL PEARLS covers, in part, "leasing access to an on-line computer program for use in the management of patient medical records," the registrations for both MEDICAL PEARLS and PEARL ONLINE cover the service of providing physicians with information in the field of patient medical records. This could very well include information on managing, storing, and safeguarding such records, by physicians in their own practices. We agree with the examining attorney that such a service would be encompassed within applicant's identification of services, which covers providing physicians with information on, inter alia, "general practice management." We see no

reason not to consider patient medical records an aspect of a physician's practice that must be managed.

In sum, we find the mark PRACTICE MANAGEMENT PEARLS and the registered marks MEDICAL PEARLS and PEARL ONLINE to be very similar in overall commercial impression and applicant's and registrant's services to be very similar, if not overlapping. Under these circumstances, those familiar with registrant's marks and services, who subsequently encounter applicant's mark and services, will likely be confused as to source, sponsorship or affiliation of the respective on-line offerings.⁵

We now turn to the examining attorney's refusal based on the prior registration of the mark PEARLS FOR YOUR PRACTICE. We find this mark even more similar to applicant's mark than are the other two registered marks already discussed herein, though we find the goods and services for which this mark is registered less similar to applicant's services.

PEARLS FOR YOUR PRACTICE and PRACTICE MANAGEMENT PEARLS both are multi-word slogans that include the terms

⁵ We are not persuaded that we should reach a contrary conclusion because of applicant's claim that its services are obtained by subscription and its subscribers will know the web site they are visiting. Applicant's identification does not limit its services to subscribers, and we must consider the identification to include posting of an on-line magazine that is available to all who have connections to the Internet.

PEARLS and PRACTICE. Thus, they are similar in sound and appearance, notwithstanding that the position of the two terms is reversed in each mark. More importantly, the connotations of PEARLS FOR YOUR PRACTICE and PRACTICE MANAGEMENT PEARLS are virtually identical, specifically bringing to mind the idea of "pearls of wisdom" or useful tips on the management of a health care practice.

The goods and services with which these marks are identified, however, are different. PEARLS FOR YOUR PRACTICE is registered for "column reprints and supplements to magazines relating to the dental field," in International Class 16. Thus, although registrant's mark is identified with supplements to magazines and applicant's mark is identified with magazines, they are different insofar as registrant's are "hard-copy" printed publications and applicant's are "electronic," on-line publication services. Nonetheless, it has been held that posting of pamphlets on an Internet site, by one with a registration of a mark only for Class 16 pamphlets, "is a natural extension of [the registration] in view of the new technology of the Internet." Jews for Jesus v. Brodsky, 993 F.Supp. 282, 46 USPQ2d 1652, 1666 (D.N.J. 1998), *aff'd without published opinion*, 159 F.3d 1351 (Table)(3rd Cir. 1998).

We consider posting of columns and magazine supplements on the Internet or on a web page to be within the scope of natural expansion of the activities (column reprints and magazine supplements) of the owner of the mark PEARLS FOR YOUR PRACTICE. As noted in Mason Engineering & Designing Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985):

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services, but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. See: The May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978). This is so whether or not the first user of the mark has actually expanded its use of its mark, after the commencement of the subsequent user's use, to goods or services which are the same as or closely related to those of the subsequent user. See: Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329 (TTAB 1979).

Further, we consider applicant's services, as identified, to encompass providing on-line magazines to dentists as well as physicians, insofar as the identification reads "...providing on-line magazines relating to business, marketing, financial and general practice management for physicians and **medical personnel** via a

global computer network" (emphasis added). This identification does not limit the target class of consumers to physicians, or physicians and medical personnel employed by physicians. "Medical personnel" is a broad term that we read to include dentists. Compare "**physician** 1. A person licensed to practice medicine; medical doctor..." and "**medicine** 1. The science of diagnosing, treating, or preventing disease and other damage to the body or mind..." on the one hand, and on the other, "**dentist** A person whose profession is dentistry," and "**dentistry** The diagnosis, prevention and treatment of diseases of the teeth and related structures, including the repair or replacement of defective teeth." *The American Heritage Dictionary of the English Language* 353, 815, and 989 (New College Ed. 1976).

In sum, we find PEARLS FOR YOUR PRACTICE and PRACTICE MANAGEMENT PEARLS to be very similar marks and find the goods and services identified by the respective marks to be sufficiently related so that there is a likelihood of confusion. If there were any doubt about this conclusion, we would, of course, resolve that doubt in favor of the owner of the registration of PEARLS FOR YOUR PRACTICE. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Decision: The refusal of registration under Section 2(d) of the Lanham Act is affirmed as to each of the cited registrations.